

REMARKS

Applicants acknowledge with thanks the Examiner's statement that claims 70, 73 and 76 are in condition for allowance.

Amendments to the Specification

Applicants have amended the specification to correct an inadvertent clerical error in a SEQ ID NO identifier.

Amendments to the Claims

Applicants have cancelled claims 33, 35-43, 51, 52, 59, 66, 77 and 81-83, without prejudice. Applicants expressly reserve the right to pursue the cancelled subject matter in one or more applications that claim priority under 35 U.S.C. § 120 from this application.

Applicants have amended claim 57 to incorporate the subject matter of claim 59.

Applicants have amended claims 67, 74, 78, 79 and 85 to correct dependencies. Applicants have amended claim 80 to specify that the inhibitor is a nucleic acid composition. This amendment finds support in the application as filed, see, e.g., page 9, lines 15-22; page 10, lines 22-32; page 11, lines 1-8 and 18-24; page 26, lines 16-28; page 27, lines 8-12; and page 38, lines 29-33.

Applicants have amended claims 84 and 85 to improve their clarity.

Applicants have added new dependent claims 86-97. These claims find support in the application, as filed, for example at page 25, lines 19-26.

Upon entry of the amendments, claims 57, 58, 60-65, 67, 70, 73-76, 78-80 and 84-97 will be pending in this application.

No new matter is introduced by the amendments. Applicants request entry of the amendments and consideration and allowance of the claims.

Claim Objections

The Examiner objects to claim 84 and requests clarification of whether the recited sequences SEQ ID NOs: 21 and 22 are antisense sequences or target sequences. The Examiner notes that claim 84 is directed to a nucleic acid molecule that is complementary to SEQ ID NO: 21 or 22, indicating that these are the target sequences, but page 60 of the specification states that SEQ ID NOs: 21 and 22 are "siRNAs targeting the sense strand of mRNA," suggesting that SEQ ID NOs: 21 and 22 are themselves the antisense sequence. Applicants note that the specification at page 14, lines 6-8 states:

"Figure 7 shows that the ICT1024 siRNA Design: two 21 nt sequences from ICT1024 were selected as the targets for RNAi-mediated knockdown of ICT1024 gene expression. (SEQ ID NO: 25 and SEQ ID NO: 26)"

SEQ ID NOs: 25 and 26 are identical to SEQ ID NOs: 21 and 22, respectively.

Accordingly, this objection may be withdrawn.

Rejections under 35 U.S.C. § 112

I

Claim 85 stands rejected under 35 U.S.C. § 112, second paragraph, for indefinite claim scope. The Examiner notes that claim 85 recites the limitation "the antisense nucleic acid of claim 81," and that there is insufficient antecedent basis for this limitation because claim 81 does not recite a nucleic acid. Applicants have amended claim 85 so that it depends from claim 84, which recites a nucleic acid molecule. Applicants request withdrawal of this rejection.

II

Claim 77 stands rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Solely to expedite allowance and without admitting the correctness of this rejection, Applicants have cancelled claim 77. Applicants expressly reserve the right to pursue the cancelled subject matter in one or more applications that claim priority under 35 U.S.C. § 120 from this application. Applicants request withdrawal of this rejection.

III

Claims 33, 35, 43, 51, 52, 57, 58, 77 and 79-83 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. According to the Examiner, the claims embrace the use of nucleic acid based inhibitors as well as non-nucleic acid inhibitors, such as protein antagonists and small molecules. The Examiner acknowledges that the specification exemplifies the use of siRNA targeted to ICT1024 and that those of skill in the art are aware that nucleic acid based inhibitors can be designed for any gene whose sequence is known. However, the Examiner is of the view that the skilled artisan cannot envision the detailed structure of the full genus of the encompassed inhibitors of ICT1024, particularly non-nucleic acid inhibitors. The Examiner further states that claims 59-65 and 75 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Solely to expedite allowance and without admitting the correctness of this rejection, Applicants have cancelled claims 33, 35, 43, 51, 52, 77, and 81-83 and

have amended the pending claims to recite ICT1024 inhibitors that are nucleic acids. Specifically, claim 57 is directed to a method that utilizes a nucleic acid inhibitor. Claim 79, as amended, depends from claim 57. Applicants have amended claim 80 to specify that the inhibitor is a nucleic acid composition. Applicants expressly reserve the right to pursue subject matter related to non-nucleic acid-based inhibitors of ICT1024 in one or more applications that claim priority under 35 U.S.C. § 120 from this application. In view of the claim amendments, Applicants request withdrawal of this rejection.

IV

Claims 33, 35-43, 51, 52, 66, 67, 74, and 77-83 stand rejected under 35 U.S.C. § 112, first paragraph, for lack of enablement. The Examiner states that while the specification is enabling for reducing breast cancer growth and increasing apoptosis and reducing proliferation of breast cancer cells, it does not provide enablement for reducing precancerous growths of any type or for reducing growth or proliferation of other cancers. Applicants respectfully submit that claim 80 should not be subject to this rejection because, after the current amendments, it is drawn to a method for reducing ICT1024 expression in a cell, comprising administering an inhibitor of ICT1024 polypeptide, DNA or RNA, wherein the inhibitor is a nucleic acid composition and wherein the inhibitor reduces the expression of ICT1024 polypeptide, DNA or RNA. This claim does not refer to reducing growth of any type of cancer, increasing apoptosis in any cell or reducing proliferation of any type of cancer cell.

Solely to expedite allowance and without admitting the correctness of this rejection, Applicants have cancelled claims 33, 35-43, 51, 52, 66, 77 and 81-83.

Claims 67, 74, 78 and 79 have been amended so that they depend from claims indicated by the Examiner as allowed or allowable. Applicants expressly reserve the right to pursue subject matter related to the cancelled claims in one or more applications that claim priority under 35 U.S.C. § 120 from this application. Accordingly, Applicants request withdrawal of this rejection.

CONCLUSION

Applicants request favorable consideration of the application and early allowance of the pending claims. To that end, the Examiner is invited to telephone the undersigned to discuss any issue pertaining to this reply.

Respectfully submitted,

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